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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/803,237	03/18/2004	Beat Heer	A01503	5627

7590

09/07/2005

Kenneth Crimaldi
Rohm and Haas Company
100 Independence Mall West
Philadelphia, PA 19106

EXAMINER

PRYOR, ALTON NATHANIEL

ART UNIT	PAPER NUMBER
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1616

DATE MAILED: 09/07/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/803,237

Applicant(s)

HEER ET AL.

Examiner

Alton N. Pryor

Art Unit

1616

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☐ Claim(s) 1-9 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☐ Claim(s) 1-9 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. ____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____. |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>6/17/04;3/18/04</u> . | 6) <input type="checkbox"/> Other: ____. |

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DETAILED ACTION

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1,2,9 are rejected under 35 U.S.C. 103(a) as being unpatentable over Yamaguchi (JP 2001302418; 10/31/01). Yamaguchi teaches a composition comprising a number of benzoisothiazolone compounds including 2-methyl-1,2-benzisothiazoline-3-on plus a number of thiazoline derivatives including 2-methyl-4-isothiazoline-3-on (MIT). Yamaguchi teaches that the composition can be included in paint. See abstract, paragraphs 1,9,13-15, claims. Yamaguchi does not teach a single composition specifically comprising 2-methyl-1,2-benzisothiazoline-3-on plus 2-methyl-4-isothiazoline-3-on. Yamaguchi does not the instant amounts / ratios of the two compounds. It would have been obvious to one having ordinary skill in the art to make a single paint composition comprising 2-methyl-1,2-benzisothiazoline-3-on plus 2-methyl-4-isothiazoline-3-on. One would have been motivated to do this since JP '418 suggests the combination. It would have bee obvious to one having ordinary skill in the art to determine the optimum amount / ratio of ingredients. One would have been motivated to do this in order to develop a paint that would have been most effective in pest control.

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Claims 3-7 are rejected under 35 U.S.C. 103(a) as being unpatentable over Yamaguchi (JP2001302418; 10/31/01) as applied to claims 1,2,9 above in view of Buckley et al (US 4295887; 10/20/81). Yamaguchi teaches all that is recited in claims 3-7 except for the paint composition comprising 2,2'-bis(methylaminocarbonyl) dipenyldisulphide (macdd or dmbta) and the instant ratios of dmbta to mit. However, Buckley teaches a paint composition comprising dmbta for controlling pests. See abstract, example 8. It would have been obvious to one having ordinary skill in the art to combine the two prior art compositions to arrive at a single composition comprising both mit and dmbta. One would have been motivated to do this since both prior art compositions are individually taught to control pests in paint. It would have been obvious to one having ordinary skill in the art to determine the optimum amount / ratio of ingredients. One would have been motivated to do this in order to develop a paint that would have been most effective in pest control.

Claims 1,2,9 are rejected under 35 U.S.C. 103(a) as being unpatentable over Antoni-Zimmermann et al (US 6361788; 03/26/02). Antoni-Zimmermann teaches a fungicidal paint composition comprising 1,2-benzisothiazolin-3-one plus 2-methylisothiazolin-3-one (MIT). See abstract, column 1 lines 11-37, column 4 lines 12-13, 55-57, claims. Antoni-Zimmermann composition differs from instant composition in that the instant composition comprises methylated-1,2-benzisothiazolin-3-one. It would have been obvious to one having ordinary skill in the art to employ the methylated-1,2-benzisothiazolin-3-one instead of 1,2-benzisothiazolin-3-one at the time of the prior art invention (Note the structures differ in H versus methyl). One would have been

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motivated to do this since H and methyl have similar polarity and therefore would have been expected to exhibit similar pesticidal activity. Antoni-Zimmermann does not teach the instant amounts / ratios of the two compounds. It would have been obvious to one having ordinary skill in the art to determine the optimum amount / ratio of ingredients. One would have been motivated to do this in order to develop a paint that would have been most effective in pest control.

Claims 3-7 are rejected under 35 U.S.C. 103(a) as being unpatentable over Antoni-Zimmermann et al (US 6361788; 03/26/02) as applied to claims 1,2,9 above in view of Buckley et al (US 4295887; 10/20/81). Antoni-Zimmermann teaches all that is recited in claims 3-7 except for the paint composition comprising 2,2'-bis(methylaminocarbonyl) dipenyldisulphide (macdd or dmbta) and the instant ratios of dmbta to mit. However, Buckley teaches a paint composition comprising dmbta for controlling pests. See abstract, example 8. It would have been obvious to one having ordinary skill in the art to combine the two prior art compositions to arrive at a single composition comprising both mit and dmbta. One would have been motivated to do this since both prior art compositions are individually taught to control pests in paint. It would have been obvious to one having ordinary skill in the art to determine the optimum amount / ratio of ingredients. One would have been motivated to do this in order to develop a paint that would have been most effective in pest control.

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Telephonic Inquiry

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Alton N. Pryor whose telephone number is 571-272-0621. The examiner can normally be reached on 8:00 a.m. - 4:30 p.m..

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Gary Kunz can be reached on 571-272-0887. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Alton Pryor
Primary Examiner
AU 1616